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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| RALPH E. JOCKE | | | EXAMINER | |
| walker & jockey LPA | | | HESS, DANIEL A | |
| 231 SOUTH BROADWAY | | | ART UNIT | PAPER NUMBER |
| MEDINA, OH 44256 | | | | 2876 |

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/797,712 | SCARAFILE ET AL. | |
| | Examiner | Art Unit | |
| | Daniel A. Hess | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 29 and 30 is/are allowed.
- 6) Claim(s) 1-8, 12, 14 and 23-28 is/are rejected.
- 7) Claim(s) 9-11, 13 and 15-22 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

This action is in response to 9/6/2005 arguments and amendment by the applicant, which have been placed in the file of record.

See especially the 'Response to Arguments' section below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8, 12, 14, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isozaki et al. (US 4,919,058) in view of Gardner (US 5,929,413).

Re claim 1: Isozaki et al. teaches a system whereby (see figure 1) an internal mechanism of an ATM machine can be moved away from the opening for servicing, such that a gate closes at the fascia opening upon removal of the card. It is clear (see figure 4) that the internal mechanism 58 includes a card reader, because ref. 60, which leads into it, is a card slot.

Isozaki recites (column 2, lines 25-45):

“resilient means for **urging said door to a closed position** in which it covers said aperture; operating means for moving said door from closed position to open position against the influence of said resilient means; support means fixed to said housing; lever means pivotally mounted on said support means and having one end coupled to said operating means; follower means mounted on the other end of said lever means; and engaging means fixed to said mechanism and engageable with said follower means as said mechanism is moved in a **first direction to a position in which said projecting portion projects through said aperture**, whereby movement of said mechanism in said first direction causes said engaging means to move said lever means to cause said operating means to move said door to open position, and **whereby when said mechanism is moved in a second opposite direction so that said projecting portion is withdrawn from said aperture, said**

**engaging means is moved out of engagement with said follower means to permit
said resilient means to move said door into closed position.”**

Here, clearly Isozaki teaches a system wherein a gate closes when an internal mechanism is moved away for servicing.

Isozaki does not, as far as this examiner is aware, discuss capture bins.

Gardner teaches (see figure 3) an ATM internal configuration where card capture bin 80 abuts the card reader 60. That the bin such a bin would have a door (closing member) is clear, because otherwise there would be no way to access the contents thereof. In particular, without a door, the bin would fill and then render the ATM inoperable. Further, if a card is improperly captured, it would be accessed to be returned to the user.

In view of Gardner's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known card capture bin as taught by Gardner in the teachings of Isozaki because thus cards which are judged to be fraudulent or cards which have been cancelled by the accountholder can be cancelled. It is noted that this is a feature generally common to most modern ATMs.

Isokaki/Gardner also fail to teach a card holding bin that is integrally constructed with the reader, as claim 1 appears to suggest.

However, the examiner takes the position that making the holding bin integral would have been a matter of obvious design choice. Some motives to make the holding bin integral include that this could result in a simpler design and also that one servicing the reader would not have to reattached a reader to a card holding bin after servicing if it is integral with the bin.

The following is an MPEP excerpt which addresses making components integral with one another. Regarding comparisons with Larson, it is noted that in Garder the reader and the storage bin are rigidly secured together as part of a single system.

2144.04

B. Making Integral

In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice."); but see Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what

had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.).

Re claim 2: In Isozaki (column 3, lines 55-60) it is clear that the shutter has a downward motion.

Re claims 3 and 4: Having a lock on a bin which stores ATM cards is typical in the art. In ATMs, the need to lock components which store financially valuable items is well-known. In fact, in locking a compartment which stores valuables is old and well-known, for theft prevention.

Re claims 5 and 6: The method described is the standard approach in the art for capturing a card. A card is read, and if it is determined to be invalid or cancelled, it is sent to a bin such as the bin 80 of Gardner figure 3. A controller lies at the heart of every ATM, controlling the various actions.

Re claims 7 and 8: See figure 3 of Gardner: The card 99 is moved away from the reader 61 and the card is in operative engagement with moving members, including the many rollers shown in figure 3 of Gardner.

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Re claim 12: As the excerpt of Isozaki et al. (see discussion re claim 1) shows, the gate moves back to its retracted position, after having moved downward to block the fascia opening, when the internal mechanism (which includes the reader) is inserted into the opening.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isozaki/Gardner as applied to claim 1 above, in view of Beck et al. (US 4,612,864).

Isozaki fails to teach the use of a cam surface in producing the movement of Isozaki's gate.

Beck et al. teaches a gate for the fascia of an ATM during servicing which uses a cam surface to effect movement (column 4, lines 30-50):

"Locking pawl 31 is shown in detail in FIGS. 13 and 14. Pawl 31 includes an arm 111, an upwardly extending tab 113 for blocking the movement of arm 98 of Geneva claw 29 when door 23 is closed, a downwardly extending tab 115, a generally curved surface 117, a **rearward cam surface** 118, a **forward cam surface** 119, a hole 120 and a hole 121 through tab 115. A post 123 extends through hole 120, through a spacer 124, a bushing 125 and a similar aligned hole in platform 87 to pivotally mount locking pawl 31 on the platform. (See FIG. 4).

The ends of post 123 are threaded, and a threaded cap 126 retains pawl 31 on post 123, and a nut 127 holds post 123 in platform 87. A tab 128 extends upwardly on platform 87, and is provided with a hole; a wire coil spring 129 extends at one of its ends through the hole in tab 128 and at its other end through hole 121 in tab 115, for biasing pawl 31 in the clockwise direction as

shown in FIG. 3 to place the pawl in its blocking position as discussed below."

In view of Beck et al.'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known cam surface to move the gate because such a mechanical arrangement is both sturdy and durable.

Re claims 26 and 27: To have a reader move along a slide is old and well-known, where the reader must be removed for access and servicing.

The floppy drive of a computer, for example moves into a drive bay by essentially by sliding in. The portion of the computer chassis that receives the drive is essentially a slide. A floppy disk drive is essentially a type of reader.

In view of the well-known arrangement of a floppy drive in a computer chassis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known sliding arrangement for the card reader in the housing of the instant invention.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Isozaki/Gardner as applied to claim 1 above, in view of Mair et al. (US 6,367,695).

Isozaki/Gardner fails to teach a sensing device for detecting objects placed in front of the card slot.

Mair et al. teaches this in the abstract and throughout, including claim 1. In view of Mair et al.'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known detector for detecting objects in front of the ATM face because this can deter would-be card data thieves.

Claim 28, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner in view of Fish (US 4,442,781).

Re claims 28 and 23: Gardner teaches (see figure 3) an ATM internal configuration where card capture bin 80 abuts the card reader 60. That the bin such a bin would have a door (closing member) is clear, because otherwise there would be no way to access the contents thereof. In particular, without a door, the bin would fill and then render the ATM inoperable. Further, if a card is improperly captured, it would be accessed to be returned to the user.

Lacking in Gardner is a teaching that the capture bin door is a locking lid.

Fish teaches a storage box inside an ATM machine that has a locking lid to give authorized personnel access to the contents of the box (column 1, lines 55-60): "A further object of the present invention is to provide a removable lid for a deposit box, for allowing easy access to the interior of the deposit box when the lid is removed, with key-operated means for locking the lid in position, and for cocking the doors of such box for automatic locking."

In view of Fish's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known locking lid as taught by Fish for the storage box of Garder because a lid that is on top would avoid the problem of cards falling out that would occur for a door that is on the side of the card capture bin.

Re claim 25: It is typical for most parts, including a card capture bin, to be moveable, at least for servicing. As for the card capture bin moving *with* the card reader, this would have been obvious: See the discussion of making those two parts integral, re claim 1, above.

Allowable Subject Matter

Claims 9-11, 13, 15-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Re claim 9: The prior art fails to teach or fairly suggest, in the context of the various other limitations upon which the claims depend, throwing, via a flexible member, a card into a receptacle of an ATM machine. The nearest prior art generally shows that captured cards are tossed into a receptacle generally by being dropped, or pushed by rollers which come to an end at an entry to the receptacle. What is lacking is a resilient member that serves to actually throw the card. This is shown in figures 19 and 20 of the instant application, where the resilient member and the throwing action can clearly be seen. See also allowed copending application 10/797,412, which recites a similar limitation.

Re claim 16: The prior art of record fails to teach or fairly suggest that in the context of all of the other limitations upon which the claim depends in addition to the reader being moveably disengagable from the fascia, the fascia is itself moveably mounted relative to the remainder of the housing.

Some ATMs may have a removable cover for enabling servicing, but in this case, the internal components of the ATM would be accessed through the front and then would not need to be accessed through the rear, and thus the card reader system would not need to move backward.

In Isozaki et al. (see figure 4) the card reader system (including the card opening 40) move backward away from the fascia of the ATM; thus there would be no apparent purpose for the fascia of that ATM to move.

The applicant has demonstrated with respect to this particular limitation a usefulness in terms of hindering the placement of foreign objects in front of the card slot, because the alignment of the card slot changes. Such an advantage was not suggested in the prior art of record.

Others of the above claims depend from one or both of claims 9 and 16.

Claims 29 and 30 are allowed, for reasons similar to those re claim 9 above: having resilient member that is operative to throw the card in the bin away from the card reader. See also allowed copending application 10/797,412, which recites a similar limitation.

Response to Arguments

Applicant's arguments filed 9/6/2005 have been fully considered but they are not persuasive.

The applicant has argued that the examiner has not provided any evidence in support of his assertion that it would have been obvious to make the holding bin integral. In fact the examiner has.

Firstly, the examiner notes that motivation was given. In fact, two motivations were given! The following is an excerpt from the previous action (pages 4 and 5):

“Some motives to make the holding bin integral include that this could result in a simpler design and also that one servicing the reader would not have to reattached a reader to a card holding bin after servicing if it is integral with the bin.”

Secondly, the examiner notes that motivation need not be explicitly recited in the prior art. It may be implied. Or it may be drawn from general knowledge of those of ordinary skill in the art, as is the case here.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH
11/03/05

DANIEL STCYR
PRIMARY EXAMINER

